

In Re Application of:

Yoshihide ITEYA

Serial No.: 09/785,026

Filed: February 15, 2001

For: **BICYCLE CONTROL DEVICE**

Art Unit: 3682

Examiner: Vinh T. Luong

Mail Stop Appeal Brief
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AMENDED SECOND SUPPLEMENTAL APPEAL BRIEF

In response to the Notification of Non-Compliant Appeal Brief dated April 5, 2006 and the Office Action, dated May 27, 2005, Applicant submits this Amended Second Supplemental Appeal Brief and requests reinstatement of its previously filed appeal. It is believed that no fee is due for filing this brief. However, if a fee is due, authorization is hereby given to charge any fee (or credit any balance) to the undersigned deposit account 10-0440.

This is an appeal from the decision dated May 27, 2005, rejecting claims 1 and 3-27 as unpatentable under 35 U.S.C. § 112, ¶ 1; rejecting claims 1 and 3-27 as indefinite under 35 U.S.C. § 112, ¶ 2; rejecting claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 as being anticipated under 35 U.S.C. § 102(b) by Abe, U.S. Patent No. 6,073,730 ("Abe"); rejecting claims 7 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of Seimitsu, Japanese Patent

Amended Second Supplemental Appeal Brief

-1-

Appl. No. 09/785,026
Atty. Docket No. 57139-5045
Customer No. 24574

Application JP 20026893 ("Seimitsu"); rejecting claims 8 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of Miyoshi et al., Japanese Patent Application JP 04048521 ("Miyoshi"); rejecting claims 12 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of Hill et al., U.S. Patent No. 5,745,438 ("Hill"); and rejecting claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of Chou, U.S. Patent No. 5,370,412 ("Chou").

TABLE OF CONTENTS

| | |
|---|----|
| REAL PARTY IN INTEREST | 4 |
| RELATED APPEALS AND INTERFERENCES | 5 |
| STATUS OF CLAIMS | 6 |
| STATUS OF AMENDMENTS | 7 |
| SUMMARY OF CLAIMED SUBJECT MATTER | 8 |
| GROUND OF REJECTION TO BE REVIEWED ON APPEAL..... | 11 |
| ARGUMENT | 12 |
| CONCLUSION | 25 |
| CLAIMS APPENDIX | 26 |
| EVIDENCE APPENDIX | 33 |
| RELATED PROCEEDINGS APPENDIX | 34 |

REAL PARTY IN INTEREST

The real party in interest is Shimano Inc., the assignee of the subject application.

RELATED APPEALS AND INTERFERENCES

An appeal is currently pending for commonly-owned U.S. Patent Application Serial No. 10/654,357 ("the '357 Application"). The appeal of the '357 Application is not believed to be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal. To date, however, no decision by the Board has been rendered in the appeal of the '357 Application.

STATUS OF CLAIMS

Claim 2 has been canceled. Claims 1 and 3-27 remain pending, have been rejected, and are the subject of this appeal.

STATUS OF AMENDMENTS

No claim amendments were submitted or entered following the final rejection, dated May 27, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

Modern bicycles frequently include a number of control devices that enable a rider to optimize his or her ride. Typical control devices include brake control devices, shift control devices, and combinations of the two. In addition, modern bicycles frequently include cycle computers that provide riders with information about their ride on computer screens. It is desirable to locate such computer screens directly in front of the rider, but locate the control device away from the computer, near the bicycle's handle grips. This minimizes the need for the rider to move his or her hands between the control device and the control switch, which can impair the ability to steer and control the bicycle. In addition to the foregoing, it is desirable to provide a control switch assembly having a structure and configuration that allow for relatively simple and inexpensive installation. Thus, a need has arisen for a bicycle control switch which addresses these concerns (See page 1, line 16-page 2, line 18 and page 6, lines 1-8).

The present invention fulfills these needs. Without limiting the scope of the present invention in anyway, the independent claims on appeal are summarized as follows: Claim 1 is directed to a bicycle switch mounting assembly comprising a bicycle control device (20) having a top surface that defines a recess (42) in the device (See page 4, line 23 to page 5, line 11 and page 6, lines 17-27). The recess has a bottom wall and a side wall connected to the bottom wall. The claimed mounting assembly further comprises an operation control button (40) with an outer periphery having a shape (See page 5, lines 21-34). The operation control button is movable within the recess, and the recess has a shape which conforms to the shape of the outer periphery of the operation control button (See page 6, lines 17-27).

Independent claims 3 and 4 are directed to a bicycle switch mounting assembly for holding a computer control switch (40). Claim 3 recites a bicycle shift control device (20), and claim 4 recites a bicycle brake control device (20) (See page 4, line 23 to page 5, line 11). The respective control devices comprise a top surface defining a recess (42) that is dimensioned to

receive an operation control button (40) (See page 5, lines 21-34). The recess also has a shape conforming to the outer periphery of the operation control button, and the control button is movable within the recess (See page 6, lines 17-27).

Independent claim 5 is directed to a control device (20) for holding a computer switch (40) (See page 5, lines 21-34). The control device (20) comprises an integrated brake and shift control device and an operation control button (40) (See page 4, line 23 to page 5, line 11). A casing having a recess (42) encompasses the brake and shift control devices. The recess (42) is dimensioned to receive the computer control switch (40) and has a shape conforming to the shape of the outer periphery of the operation control button (40). The operation control button is movable within the recess (See page 6, lines 17-27).

Independent claim 6 is directed to a bicycle switch assembly. The assembly comprises a bicycle control device (20) having a casing that defines a switch mounting recess (42). A control switch comprising an operation control button (40) is mounted in the switch mounting recess, and the recess has a shape conforming to the shape of the outer periphery of the operation control button. The operation control button is movable within the recess (See page 4, lines 23-32, page 5, lines 31-34, and page 6, lines 17-27).

Similarly, independent claim 13 is directed to a bicycle control assembly for holding a control switch for a computer (40). The control switch has an operation control button (40). The assembly comprises a control device (20) having a casing that defines a switch mounting recess (42). The recess (42) is dimensioned to receive the control switch (40) and has a shape conforming to the shape of the outer periphery of the control button (40). The operation control button (40) is movable within the recess (See page 4, line 23 to page 5, line 11, page 5, lines 31-34, and page 6, lines 17-27).

Claim 18 is directed to a handlebar assembly (10) controllable by the hand of a bicycle rider. The assembly comprises a handlebar (12) having an end (16) to which a hand grip (14) is attached (See page 4, lines 16-22). A control device (20) is attached to the handlebar (12)

proximal the hand grip (14) such that the rider's hand can reach the device while remaining on the hand grip (14) (See page 4, line 23 to page 5, line 11). The control device (20) defines a switch mounting recess (42) in which a control switch (40) is mounted. A cycle computer is attached to the handlebar separately from the control device (20) and is electrically connected to the control switch. The control switch comprises an operation control button, and the recess has a shape conforming to the outer periphery of the control button. The operation control button is movable within the recess (See page 6, lines 17-27).

Claim 20 is directed to a method of installing a control switch (40) having an operation control button (40) with an outer periphery having a shape. The method comprises providing a control switch (40) and a bicycle control device (20) having a top surface. The top surface defines a switch mounting recess (42) that comprises a bottom wall connected to a side wall. The switch mounting recess (42) is dimensioned to receive the control switch (40) and has a shape conforming to the outer periphery of the operation control button. The operation control button is movable within the switch mounting recess (See page 4, line 23 to page 5, line 11, page 5, lines 31-34, and page 6, lines 17-27).

In summary, a preferred embodiment of a control device as described by the above claims is shown in Figures 1a, 1b and 2 of the present application. According to the embodiment, a combined bicycle brake and shifting control device 20 is provided which contains a switch mounting recess 42 defined in a surface of the control device 20. See page 4, line 26 to page 5, line 2; page 6, line 22 to page 7, line 4. The recess 42 is dimensioned to receive a control switch 40 which is mounted in the recess 42. See Figures 3-7.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1 and 3-27 are unpatentable for failure to comply with the written description requirement of 35 U.S.C. § 112, ¶ 1.
2. Whether claims 1 and 3-27 are unpatentable for indefiniteness under 35 U.S.C. § 112, ¶ 2.
3. Whether claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 are anticipated under 35 U.S.C. § 102(b) by Abe.
4. Whether claims 7 and 21 are obvious under 35 U.S.C. § 103(a) over Abe in view of Seimitsu.
3. Whether claims 8 and 22 are obvious under 35 U.S.C. § 103(a) over Abe in view of Miyoshi.
4. Whether claims 12 and 26 are obvious under 35 U.S.C. § 103(a) over Abe in view of Hill.
5. Whether claims 18 and 19 are obvious under 35 U.S.C. § 103(a) over Abe in view of Chou.

ARGUMENT

After receiving Applicant's Supplemental Appeal Brief, the Examiner re-opened prosecution of this application a second time. However, she has again rejected all of the pending claims based on the same references which were previously asserted. No new references have been cited. In addition, for the first time during the four-year pendency of this application, the Examiner now asserts that Applicant's claims are indefinite and fail to comply with the Patent Statute's written description requirement. As set forth below, however, Applicant's original specification clearly supports the pending claims and conveys to one of ordinary skill in the art that Applicant was in possession of the presently claimed invention at the time the application was filed. Further, the pending claims delineate the metes and bounds of the invention with sufficient clarity, and therefore, are definite.

As also explained below, each of the Examiner's prior art rejections relies on the Abe reference. However, Abe does not disclose the subject matter of Applicant's claims and cannot be combined with the other asserted references to obtain the claimed invention. As a result, the Examiner's rejections are improper and should be withdrawn.

I. The Subject Matter of Claims 1 and 3-27 Satisfies the Written Description Requirement of 35 U.S.C. § 112, ¶ 1

The Examiner asserts that the pending claims do not satisfy 35 U.S.C. § 112, ¶ 1. The May 27, 2005 Office Action does not expressly indicate whether the rejection is based on the enablement or written description requirements of 35 U.S.C. § 112. However, based on the Examiner's January 13, 2005 Office Action, Applicant understands that it is based on the written description requirement, *not* the enablement requirement.¹

¹ In the Examiner's January 13, 2005 Office Action, she asserted that "Claims 1 and 3-27 [stand] rejected . . . as failing to comply with the written description requirement." January 13, 2005 Office Action at 2. One of the bases of this rejection was mooted by claim amendments submitted in response to the Office

As indicated in the attached Claim Appendix, each of the pending claims recites an operation control button that is connected to a control device. The top surface of the control device or its casing has a recess defined in it wherein the button is movable within the recess. According to the Examiner, the claims do not satisfy the written description requirement because "the specification does not provide support for *how* the button is movable within the recess and it appears from the drawings that the button is only movable within the recess for assembly/disassembly." May 27, 2005 Office Action at 2.

First, it should be noted that the claim limitation at issue was added to Applicant's claims in January 2003. At no time prior to the January 13, 2005 Office Action did the Examiner assert that Applicant's claims were unsupported by the original application.

Second, the Examiner's rejection is inconsistent with the pending claims. The pending claims do not recite how the switch is movable within the recess. They merely recite that the switch *is* movable within the recess. The test for sufficiency of support in an original application is "whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." See Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 865 (Fed. Cir. 1993)(citations omitted)(emphasis added). The Examiner's rejection goes to unclaimed subject matter. As mentioned above, the Examiner's rejection is based on the written description requirement--not the enablement requirement--of 35 U.S.C. § 112, ¶ 1. Because the claims do not recite how the button is movable within the recess, whether the originally-filed application describes how the button is movable is irrelevant for purposes of compliance with the written description

Action. However, the other asserted basis is the same one articulated in the pending May 27, 2005 Office Action, i.e., the alleged lack of support for a button that is movable within a control device recess. Id. at 2. Furthermore, the Examiner has made no attempt to show that the claimed invention could not be obtained without undue experimentation and has not provided any analysis of the factors set forth by the Federal Circuit or the Manual of Patent Examining Procedure for evaluating undue experimentation. See In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988); Manual of Patent Examining Procedure (8th ed., Rev. 2, 2004), § 2164.01(a). For this reason as well, it is evident that the Examiner's rejection is based on the written description requirement.

requirement.

Third, it is undisputed that Applicant's original application describes a button that is movable within a control device recess. The Examiner apparently contends that Applicant must *expressly* discuss a movable button in its specification to comply with the written description requirement. However, that is not the law. As the Federal Circuit has held:

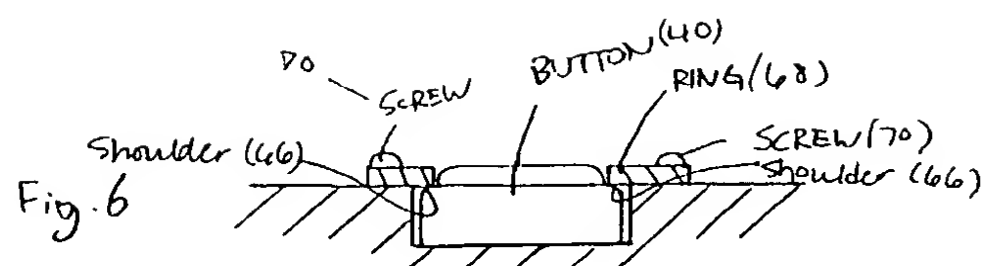
In order to determine whether a prior application meets the "written description" requirement with respect to later filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed.

Eiselstein, v. Frank, 52 F.3d 1035, 1038 (Fed. Cir. 1995).

The specification describes "a control switch 40," which in the preferred embodiment of Figures 3-7 comprises an operation control button. See Specification page 5:25-28. One of ordinary skill in the art would readily recognize that the button has to move within the recess in order to function as a switch. Moreover, the originally-filed application describes embodiments that require the use of a "thumb to operate . . . control switch 40" as well as embodiments in which "the control switch 40 is located on the control device 20 at a location that is conveniently accessible by the rider's index finger." See Specification page 6:1-5. Again, one of ordinary skill in the art would readily recognize that in order for the rider to actuate the switch with a thumb or index finger, the switch has to be movable in the recess.

Further, the embodiments of FIGS. 6 and 7 include retention rings that are expressly described as *restricting the movement* of their respective buttons, providing further support for a movable control button. For example, FIG. 6 is described as follows²:

² The version of FIG. 6 shown here is the originally-filed version. It was subsequently replaced when Applicant submitted formal drawings on February 19, 2002.



"In the embodiment shown in Figure 6, the outer casing 48 of the control switch 40 includes a shoulder 66." See Specification page 8:6-7.

"The retention ring 68 is dimensioned to *restrict the movement* of the shoulder 66 such that the shoulder 66 is *not able to move outside* of the switch mounting recess 42." See page 8:10-13 (emphasis added).

"If . . . the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the Examiner or the Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient." In re Alton, 76 F.3d 1168, 1175 (Fed. Cir. 1996). Notwithstanding the foregoing specification excerpts, the Examiner has not articulated any reason why one of ordinary skill in the art would not understand that Applicant's original application described a control button that is movable in a control switch recess. Thus, the rejection is improper and should be withdrawn.

II. The Subject Matter of Claims 1 and 3-27 is Definite Under 35 U.S.C. § 112, ¶ 2

The Examiner next contends that Claims 1 and 3-27 are indefinite under 35 U.S.C. § 112, ¶ 2. According to the Examiner, Applicant's recitation of a control button movable within a recess "is unclear, as the movement of the button within the recess is not clearly defined." May 27, 2005 Office Action at 2. More specifically, the Examiner states that "the button could be moveable only during assembly/disassembly or during operation of the button to perform a function." Id. at 2. Again, this limitation has been included in the pending claims for two years. Yet despite having issued three substantive Office Actions and two Advisory Actions since then, the alleged "indefiniteness" was not raised until the Examiner's January 13, 2005 Office Action.

"If one skilled in the art would understand the bounds of the claim when read in

light of the specification, then the claim satisfies section 112 paragraph 2." Exxon Research and Engineering Co., v. U.S., 265 F.3d 1371, 1375 (Fed. Cir. 2001). The pending claims recite a control button that is *connected to* a control device and *movable* within a recess defined in the device. There is no ambiguity as to whether the button is only moveable during assembly and disassembly. The claims clearly state that the button is movable when it is connected to the control device. The claims are not limited by assembly or disassembly terms. Thus, "the claims at issue are sufficiently precise to permit a potential competitor to determine whether or not he is infringing." Id. (citations omitted). Therefore, they meet the definiteness requirement of 35 U.S.C. § 112.

III. The Subject Matter of Claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 Is Not Anticipated by Abe Under 35 U.S.C. § 102(a)

The Examiner asserts that claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27³ are anticipated by Abe under 35 U.S.C. § 102(b). At the outset, Abe does not qualify as prior art under Section 102(b). Abe issued on June 13, 2001. As indicated by the attached filing receipt (Exh. A), the present application was filed on February 15, 2001, less than one year after Abe was issued. Accordingly, Abe's device was not "patented or described in a printed publication . . . more than one year prior to the date of the application for patent in the United States" by Applicant. 35 U.S.C. § 102(b). Thus, Abe is not prior art under Section 102(b).

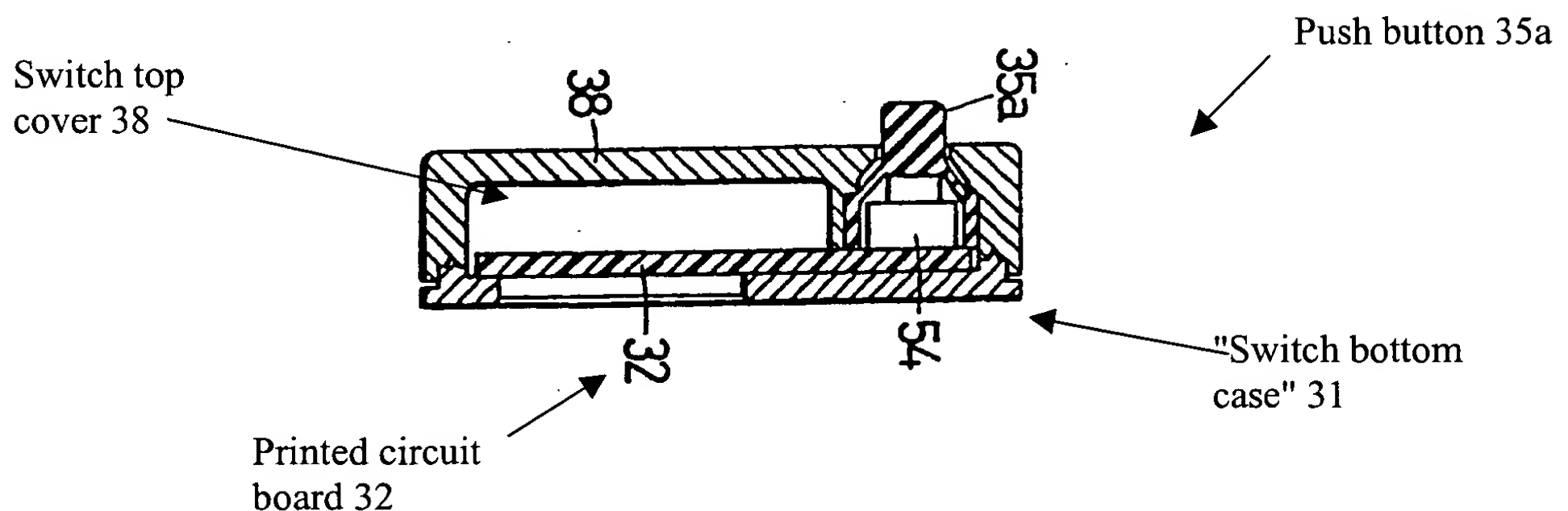
Moreover, Abe does not to disclose or suggest each of the limitations of the rejected claims, and therefore, cannot anticipate them. Claim 1 is directed to a bicycle switch mounting assembly for holding a computer control switch. It recites a bicycle control device

³ Applicant has grouped Claim 1 with the other claims that were rejected solely based on Abe. In view of 37 C.F.R. 1.192(7), Applicant is presenting its arguments for this group based on the language of Claim 1. However, the claims in this group are not all identically worded. Thus, in framing its arguments to comply with Rule 192, Applicant does not concede that each claim in this group should be construed identically with one another or that any of the claims in other designated groups should be construed identically with one another.

having a top surface that defines a recess in the device. It further recites an operation control button that is movable within the recess. The recess has a shape that conforms to the outer periphery of the operation control button. The side wall is connected to the bottom wall. The rejected claims in this group recite a structural relationship between a bicycle control device and a control button or switch which is neither suggested nor disclosed by Abe. Thus, it cannot anticipate them. See Seachange International, Inc. v. C-Cor, Inc., 413 F.3d 1361, 1379 (Fed. Cir. 2005) ("A claim is anticipated if *each and every* limitation is found either expressly or inherently in a single prior art reference") (emphasis added) (citations omitted).

Abe's device does not include a top surface that defines a recess having a connected bottom and sidewall. At most, the "top surface" or casing of Abe's device defines a bottomless hole.

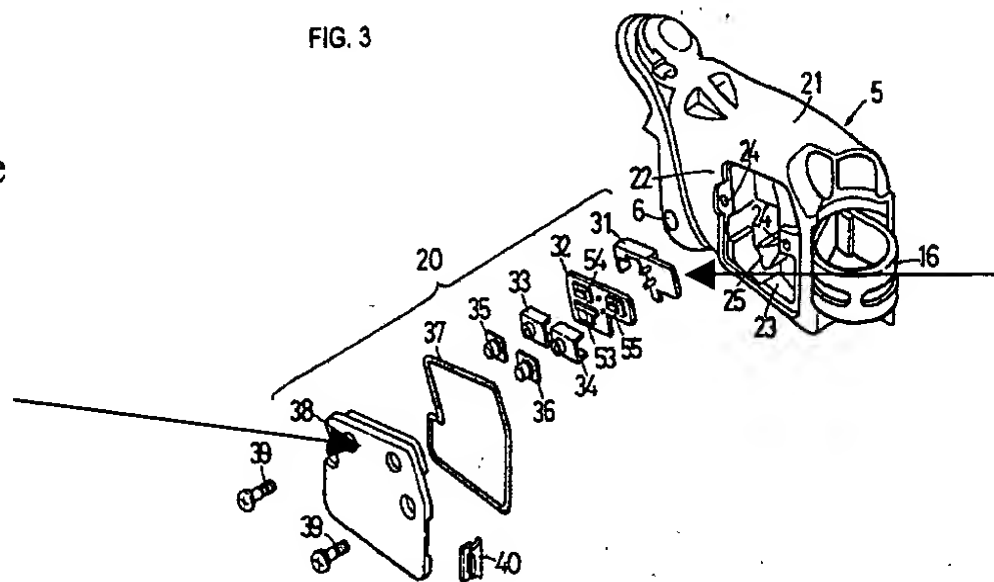
In support of her rejection, the Examiner relies on Abe's FIG. 11:



The Examiner contends that Abe's switch top cover 38 comprises "a casing (38) encompassing the brake/shift control device wherein the casing defines a recess therein, the recess having a bottom wall (31) and sidewall (38)." May 27, 2005 Office Action at 3. However Claim 1 recites "a bicycle control device having a top surface, the top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall." As

shown in FIG. 3 of Abe, the "switch top cover 38" does not have a top surface that *defines* a recess having a bottom wall and a connected sidewall. At most, its top surface defines a *hole* with no bottom wall:

Abe's "switch top casing" 38 has several *through-holes*. However, its top surface does not define a recess having a bottom wall *connected* to side walls.



The Examiner contends that "switch bottom case" 31 is a "bottom wall" of Abe's "recess."

The top surface or casing 38 does not *define* a recess that has a bottom wall. Instead, the "bottom wall" identified by the Examiner is a separate component—switch bottom case 31. Thus, Abe does not disclose the features of Claim 1 and cannot anticipate it or the remaining claims grouped with it.

IV. The Subject Matter of Claims 7 and 21 Is Not Obvious Under 35 U.S.C. § 103(a) Over Abe In View of Seimitsu

The Examiner has rejected claims 7 and 21 as obvious over Abe in view of Seimitsu. Claims 7 and 21 depend from claims 6 and 20, respectively, and they further recite the attachment of the claimed switch in the switch mounting recess by an adhesive. The Examiner has applied Abe in the same manner described above for claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27. As such, claims 7 and 21 are allowable for the same reasons that claims 6 and 20 are allowable over the prior art of record.

The rejection is further improper because Seimitsu is non-analogous art, and its combination with Abe is not motivated or suggested by the prior art. Seimitsu is a Japanese

Patent Application for which the Examiner has supplied an English-language abstract.

According to the Examiner, Seimitsu "teaches using an adhesive to attach a portable clock to a fixed base." May 27, 2005 Office Action at 4. She further asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the control switch to the switch mounting recess using an adhesive so as to provide a secure connection between the switch and recess." Id.

First, Seimitsu is non-analogous art. "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In Re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Seimitsu concerns the use of an adhesive to fix a vibration damper to a transparent base used in the liquid crystal panel of electronic devices such as a clock and telephone. It does not address control switches or techniques for mounting or attaching them. Thus, combining Seimitsu with Abe is improper.

The Examiner contends that Seimitsu "was concerned with the attachment of an electronic device to a base," and therefore, that it is analogous. May 27, 2005 Office Action at 7. However, this broad characterization of Seimitsu's disclosure does not indicate that it is "reasonably pertinent to the *particular* problem" with which the present application is concerned. See In Re Oetiker, 977 F.2d at 1447 (emphasis added). Indeed, the Oetiker court rejected an examiner's contention that garment fasteners were reasonably pertinent to the applicant's problem of fastening hose clamps, Id. at 1447, even though one could broadly characterize each of them as related to connecting discrete articles. Here too, the problem of attaching vibration dampers to phones or clocks bears too little relation to the problem of attaching switches to bicycle control devices to be "reasonably pertinent."

Second, Abe's disclosure belies the Examiner's obviousness contention. The Examiner contends that "using an adhesive to attach one member to another is old and well

known in the art " May 27, 2005 Office Action at 4 (emphasis added). However, Abe does not suggest the desirability of using an adhesive to attach its switches to a switch mounting recess. If the prior art had in fact disclosed the desirability of using an adhesive to attach a control switch in a switch mounting recess, Abe should have made use of the technique as well. However, it does not. Instead, the Examiner has selectively extracted individual elements of the claimed invention from the prior art, without any basis in the prior art for doing so. See In Re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

V. The Subject Matter of Claims 8 and 22 Is Not Obvious Under 35 U.S.C. § 103(a) Over Abe In View of Miyoshi

The Examiner has rejected claims 8 and 22 as obvious based on the combination of Abe and Miyoshi and has again indicated that Abe is applied in the same manner as for Claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27. The rejection is improper because the combined references do not teach all of the claim limitations and because there is no motivation or suggestion in the prior art for combining them.

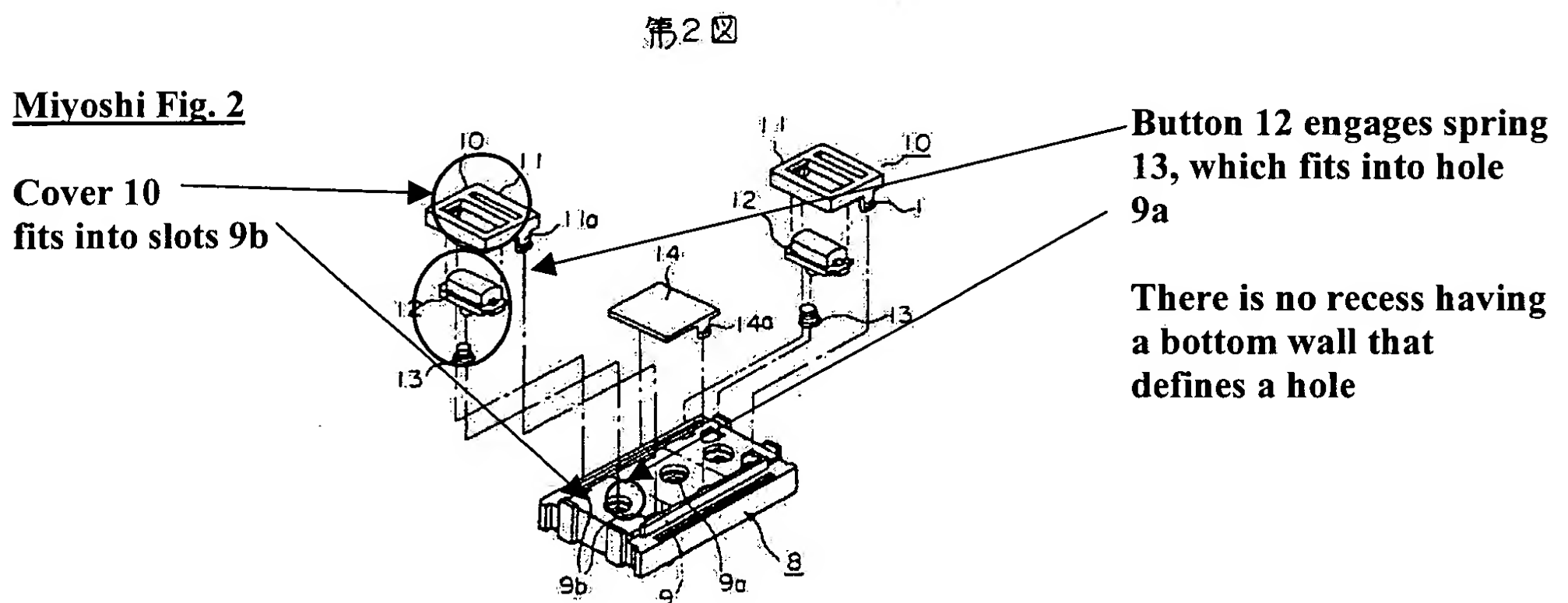
A. Abe and Miyoshi Do Not Teach or Suggest the Claimed Invention

Claims 8 and 22 depend from Claims 6 and 20, respectively, and further recite a hole in the bottom surface of the switch mounting recess and an elastic attachment arm on the operation control button, wherein the attachment arm is press fitted into the hole. Thus, claims 8 and 22 are allowable for the same reasons that claims 6 and 20 are allowable over the prior art.

In addition, Miyoshi cannot be combined with Abe to obtain the elastic attachment arm feature recited in claims 8 and 22. Miyoshi is a Japanese Patent Application for which the Examiner has provided an English-language abstract. According to the Examiner, Miyoshi discloses a "switch mounting recess defining a hole (9a, b) therein, the control switch 12 having an attachment arm 13 made of an elastic material, wherein the attachment arm is press-

fitted into the hole of the switch mounting recess." May 27, 2005 Office Action at 5. Contrary to the Examiner's assertion, Miyoshi discloses a button 12 that engages a spring 13. The spring 13 is not an "attachment arm" of the button 12, as the Examiner contends. Spring 13 appears to extend into hole 9a. However, the abstract does not describe the arrangement. Moreover, nothing in the reference indicates that spring 13 is elastic, and claims 8 and 22 recite an elastic attachment arm.

The Examiner contends that Miyoshi's spring is "inherently elastic" and that it is "used to attach the button (12) to a base." May 27, 2005 Office Action at 8. However, nothing in the translated abstract or the figures indicates that the spring "attaches" button 12 to the base. Instead, it merely appears that it biases button 12 away from case 6. The abstract states that cover 11 is attached by "fitting a projection 11a of the top cover 11 to a fitting hole 9b." However, the spring is not described as performing any attachment function and cannot fairly be characterized as an "attachment arm." Moreover, nothing in the reference indicates that attachment is an inherent feature of the spring.



The Examiner's strategy of using hindsight to selectively pick claim elements from the prior art is clearly revealed by the assertion of Miyoshi. The Examiner indicates that

holes 9a and 9b are a "switch mounting recess defining a hole." However, claims 8 and 22 require a switch mounting recess that defines a bottom wall and which comprises a bottom surface defining a hole therein. At most, Miyoshi shows a hole. It does not, however, show the claimed structure of a recess having a bottom surface defining a hole. Moreover, Miyoshi does not disclose a recess that conforms to the shape of the outer periphery of a control button, as required by the rejected claims.

B. The Examiner Has Failed to Provide a Motivation Or Suggestion In the Prior Art For Combining Abe and Miyoshi

As with the above-described rejections, the Examiner has again failed to demonstrate that the *prior art* suggested the combination of Miyoshi with Abe to obtain the claimed invention. "When an obviousness determination is based on multiple prior art references, there must be a showing of some teaching, suggestion, or reason to combine the references." Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000) (citations omitted). See also In re Stencel, 828 F.2d 751, 755 (Fed. Cir. 1987)("Nor is obviousness established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made").

The Examiner contends that "it would have been obvious . . . so as to provide a more secure and stable form of attachment for the control device switch." May 27, 2005 Office Action at 5. However, that assertion is completely unsupported. "The factual inquiry whether to combine references . . . must be based on objective evidence of record." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In Sang-Su Lee the Federal Circuit reversed a Board of Patent Appeals and Interferences finding of obviousness, holding that "[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." Id. at 1343-1344. Thus, the rejection is improper on this basis as well. See also, Application of Rice, 481 F.2d 1316, 1318 (C.C.P.A. 1973).

The Examiner defends the assertion of Miyoshi on the grounds that "reconstruction is proper" if it "takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made." However, she does not identify the alleged source of that knowledge or how it justifies the reconstruction of the references that would be necessary to obtain the claimed invention. See In Re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

VI. The Subject Matter of Claims 12 and 26 Is Not Obvious Under 35 U.S.C. § 103(a) Over Abe In View of Hill

The Examiner has rejected claims 12 and 26 as obvious based on the combination of Abe and Hill has again indicated that Abe is applied in the same manner as for Claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27. The rejection is improper because the references require modifications that are not motivated or suggested by the prior art in order to obtain the claimed invention. Moreover, Hill is non-analogous prior art, and its combination with Abe and Miike is not motivated or suggested by the prior art.

Claims 12 and 26 depend from claims 11 and 24, and are allowable for the same reasons that claims 11 and 24 are allowable over the prior art. In addition, claims 12 and 26 further recite the threaded engagement of a retention ring in the switch mounting recess. According to the Examiner, Hill "teaches a threaded retention ring used to secure a member (17) within a recess (32)." May 27, 2005 Office Action at 5. In support of her rejection, the Examiner asserts that the combination of Hill with Abe and Miike "would have been obvious . . . so as to provide a secure method of retaining the control switch within the recess that could withstand the rough conditions to which a bicycle might be exposed." Id. at 6.

First, the assertion of Hill is improper because it is non-analogous prior art. Hill does not involve control switches, or structures for retaining them within recesses. Instead, it is directed to an electrostatic transducer. The portion of Hill relied upon by the Examiner concerns

the threaded engagement of an O-ring retainer 16 in a transducer housing 11 to secure a sleeve 17. Thus, Hill it is non-analogous art, and its assertion against the present application is improper. See In Re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The Examiner has broadly characterized Hill's disclosure as related to the problem of "securing a device within a housing," and on that basis, contends that it is analogous. However, she has not demonstrated that the reference is "reasonably pertinent" to the particular problem of attaching a movable switch to a bicycle control device or within a control device switch recess, as required by the standard set forth in Oetiker.

Third, the Examiner has again failed to show a motivation or suggestion in the prior art for combining Hill with Abe. Although the Examiner identifies a benefit of threaded retention ring engagement--i.e., providing a secure method of retaining the control switch within the recess--she has not shown that this was an acknowledged goal in the prior art. She has merely provided her own unsupported contention that such was the case. See In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

VII. The Subject Matter of Claims 18 and 19 is Not Obvious Under 35 U.S.C. § 103(a) Over Abe in View of Chou

Claims 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Abe in view of Chou, U.S. Patent No. 5,370,412 ("Chou"). Claim 18 recites a handlebar assembly comprising a bicycle control device that has a top surface defining a switch mounting recess therein, the switch mounting recess having a bottom wall and a sidewall connected to the bottom wall. As explained above, Abe does not disclose this limitation. Nor does Chou. The Examiner contends that Chou discloses a cycle computer attached to a handlebar, separate from a control device. However, Chou does not disclose the claimed relationship between an operation control button and a switch mounting recess formed in a bicycle control device's top surface.

Thus, the claimed references--even if combined (which would be improper)--do not disclose all of the limitations of Claim 18 and cannot render it obvious. Claim 19 depends from Claim 18, and therefore, is allowable over the combination of Abe and Chou as well.

CONCLUSION

In view of the foregoing, it is respectfully requested that the rejection of claims 1 and 3-27 be withdrawn and that the claims be allowed.

Dated: April 24, 2006

Respectfully submitted,

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CLAIMS APPENDIX

1. (Previously Presented) A bicycle switch mounting assembly for holding a computer switch, comprising:

a bicycle control device having a top surface, the top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall;

an operation control button with an outer periphery having a shape, wherein the operation control button is connected to the bicycle control device and movable within the recess, and wherein the recess has a shape which conforms to the shape of the outer periphery of the operation control button.

2. Cancelled

3. (Previously Presented) A bicycle switch mounting assembly for holding a computer control switch comprising:

a bicycle shift control device having a top surface, the top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall;

an operation control button with an outer periphery having a shape, wherein the operation control button is connected to the bicycle shift control device and movable within the recess, and wherein the recess is dimensioned to receive the computer control switch and has a shape conforming to the shape of the outer periphery of the operation control button.

4. (Previously Presented) A bicycle switch mounting assembly for holding a computer control switch comprising:

a bicycle brake control device having a top surface, the top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall;

an operation control button with an outer periphery having a shape, wherein the operation control button is connected to the bicycle brake control device and movable within the recess, and wherein the recess is dimensioned to receive the computer control switch and has a shape conforming to the shape of the outer periphery of the operation control button.

5. (Previously Presented) A control device for holding a computer control switch comprising:

a brake control device;

a shift control device integrated with the brake control device;

a casing encompassing the brake control device and the shift control device, wherein the casing defines a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall; and

an operation control button with an outer periphery having a shape, wherein the operation control button is connected to the shift control device and movable within the recess, and wherein the recess is dimensioned to receive the computer control switch and has a shape conforming to the shape of the outer periphery of the operation control button.

6. (Previously Presented) A bicycle switch assembly, comprising:

a bicycle control device having a casing, the casing defining a switch mounting recess, the recess having a bottom wall and a side wall connected to the bottom wall; and

a control switch mounted in the switch mounting recess, wherein the control switch comprises an operation control button having an outer periphery having a shape, wherein the operation control button is connected to the bicycle control device and movable within the switch mounting recess, and the switch mounting recess has a shape conforming to the shape of the outer periphery of the operation control button.

7. (Previously Presented) The bicycle switch assembly of claim 6 wherein the control switch is attached in the switch mounting recess by an adhesive.

8. (Previously Presented) The bicycle switch assembly of claim 6 wherein the switch mounting recess comprises a bottom surface and the bottom surface defines a hole therein, the operation control button having an attachment arm made of an elastic material, wherein the attachment arm is press fitted into the hole of the switch mounting recess.

9. (Previously Presented) The bicycle switch assembly of claim 6 further comprising an elastic outer cover at least partially surrounding the control switch wherein the elastic outer cover is press fitted into the switch mounting recess.

10. (Previously Presented) The bicycle switch assembly of claim 6 further comprising a retention ring configured to restrict the movement of the control switch.

11. (Previously Presented) The bicycle switch assembly of claim 10 wherein the retention ring is fastened to the casing.

12. (Previously Presented) The bicycle switch assembly of claim 11 wherein the retention ring is threadingly engaged with the switch mounting recess.

13. (Previously Presented) A bicycle control assembly for holding a control switch for a computer, the control switch having an operation control button with an outer periphery having a shape, the bicycle control assembly comprising:

a bicycle control device having a casing defining a switch mounting recess therein, the recess having a bottom wall and a side wall connected to the bottom wall;

wherein the switch mounting recess is dimensioned to receive the control switch and has a shape conforming to the shape of the outer periphery of the operation control button, and

wherein the operation control button is connected to the bicycle control device and movable within the switch mounting recess.

14. (Original) The bicycle control assembly of claim 13 wherein the control device comprises a shift control device.

15. (Original) The bicycle control assembly of claim 13 wherein the control device comprises a brake control device.

16. (Original) The bicycle control assembly of claim 13 wherein the control device comprises a shift control device and a brake control device.

17. (Original) The bicycle control assembly of claim 13 wherein the casing defines a cable mounting recess therein, the cable mounting recess is in communication with the switch mounting recess and extending from the switch mounting recess.

18. (Previously Amended) A handlebar assembly controllable by the hand of a bicycle rider, comprising:

a handlebar having an end;

a hand grip attached to the end of the handlebar;

a bicycle control device attached to the handlebar proximal the hand grip such that the rider's hand can reach the control device while remaining on the hand grip, the bicycle control

device having a top surface defining a switch mounting recess therein, the recess having a bottom wall and a side wall connected to the bottom wall;

a control switch mounted in the switch mounted recess of the control device, wherein the control switch comprises an operation control button having an outer periphery having a shape and the switch mounting recess has a shape conforming to the shape of the outer periphery of the operation control button, and wherein the operation control button is connected to the bicycle control device and movable within the switch mounting recess;

a cycle computer attached to the handlebar, separate from the bicycle control device; and

a connecting cable electrically connecting the control switch to the cycle computer.

19. (Original) The handlebar assembly of claim 18, wherein the control device further defines a cable mounting recess therein in communication with the switch mounting recess, wherein the cable mounting recess extends from the switch mounting recess in the direction of the cycle computer, and wherein a portion of the connecting cable is mounted in the cable mounting recess.

20. (Previously Amended) A method of installing a control switch having an operation control button with an outer periphery having a shape, comprising the steps of:

providing a control switch and a bicycle control device having a top surface, the top surface defining a switch mounting recess therein, wherein the switch mounting recess comprises a bottom wall and a side wall connected to the bottom wall, wherein the switch mounting recess is dimensioned to receive the control switch and has a shape conforming to the outer periphery of the operation control button, and wherein the operation control button is connected to the bicycle control device and movable within the switch mounting recess; and

securing the control switch in the switch mounting recess.

21. (Original) The method of claim 20 wherein the step of securing the control switch comprises adhesively attaching the control switch to the switch mounting recess.

22. (Original) The method of claim 20 further comprising the steps of:
providing an attachment arm connected to the control switch, wherein the attachment arm comprises an elastic material;
providing a bottom surface of the switch mounting recess, wherein the bottom surface defines a hole therein; and
press fitting the elastic material into the hole in the bottom surface of the switch mounting recess.

23. (Original) The method of claim 20 further comprising the steps of:
providing an elastic outer cover surrounding the control switch; and
press fitting the elastic outer cover into the switch mounting recess.

24. (Original) The method of claim 20 further comprising the steps of:
providing a retention ring; and
attaching the retention ring to the control device in a manner that restricts the movement of the control switch.

25. (Original) The method of claim 24 wherein the step of attaching the retention ring to the control device includes fastening the retaining ring to a top surface of the control device.

26. (Original) The method of claim 24 wherein the step of attaching the retention ring to the control device includes threadingly engaging the ring with the switch mounting recess.

27. (Previously Presented) The bicycle switch assembly of claim 9 wherein the elastic outer cover is in frictional contact with and surrounded by a recess wall.

EVIDENCE APPENDIX

None.

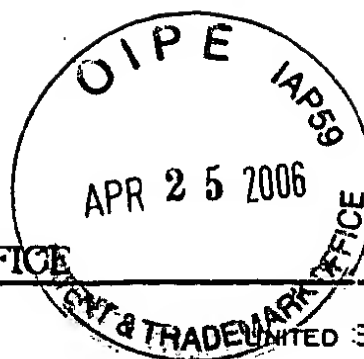
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57139-5045



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| 09/785,026 | 02/15/2001 | 3613 | 1348 | 57139-5045 | 4 | 26 | 8 |

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Applicant(s)

Yoshihide Iteya, Osaka, JAPAN;

Domestic Priority data as claimed by applicant

Foreign Applications

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Early Publication Request: No

Title

Bicycle control device

Preliminary Class

188

CALENDAR

Prior. Deadline: 2/15/01

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Title: BICYCLE CONTROL DEVICE



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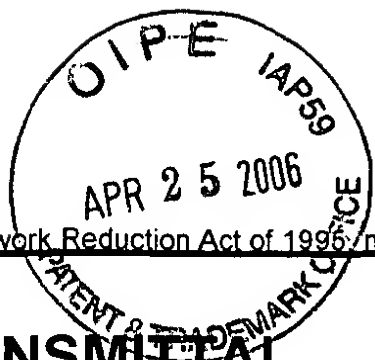
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| First Named Inventor | Yoshihide ITEYA |
| Art Unit | 3682 |
| Examiner Name | Vinh T. Luong |
| Attorney Docket Number | 57139-5045 |

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| Printed name | Brennan C. Swain | | |
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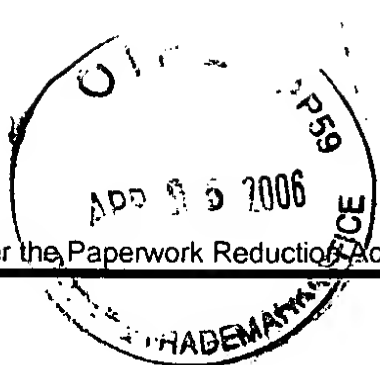
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